Remarks/Arguments

This paper is filed in reply to the Interview Summary Record dated June 13, 2008. Each rejection is set forth under a separate heading.

Interview Summary

The undersigned wishes to thank the Examiner for the interview on May 28, 2008. The Examiner's interview summary record dated June 13, 2008 is correct, except for the stated date of the interview.

Double patenting

The double patenting rejections have been maintained. Certain overlapping claims were presented in USSN 10/659,090. A terminal disclaimer has been filed herewith.

35 USC 112, second paragraph

Claims 48, 51, 52 and 54 have been rejected as including words such as "substantially" and "essentially," stating that the specification does not provide definitions of these terms. The terms are used to define physical characteristics of the claimed materials. For example, one claim refers to "substantially no difference in Gauss readings" (claim 51). One claim refers to one surface being "substantially free of spots of magnetic attraction," noting that at least another surface must possess one or more spots of magnetic attraction. The Examiner asserts that the claims are indefinite as the person of ordinary skill in the art could not understand the metes and bounds of the claim absent specific guidance in the specification. Applicants disagree. Terms of relativity are particularly appropriate where a physical property is being measured. Because measurements inherently possess differences e.g., in fluctuation, background levels, and errors due to the equipment, introduced by the environment and even variability in the material to be measured, any and all measurements must be qualified by approximation. Thus, it would be meaningless to define a material as having no difference in Gauss reading, for example, because that is a nearly impossible standard to achieve with the equipment available today. That said, the person of skill in the art would understand that

the invention relates to copper showing properties of magnetism, not caused by doping. Given the data presented in the specification describing the magnetism, one of skill in the art would certainly understand the metes and bounds of the claims presented herein, even if the specification as filed does not provide a brightline definition as to what is meant by "substantially no difference in Gauss readings," for example.

Furthermore, the Examiner has already allowed claims with similar terminology in US Patent 7,238,297. It appears that this rejection is contradictory to the allowance of this patent.

Withdrawal of the rejection is respectfully requested.

35 USC 112, first paragraph

The Examiner has rejected claims 51-54 stating that the specification does not describe the invention or enable one of ordinary skill in the art to make or use the full scope of the claims.

Claims 51-54 differ primarily from the claims granted in US Patent 7,238,297 in that the limitation that the product be made by an iterative process (in the presence of carbon) has been deleted and additional inherent properties are described. As described in the parent application, the physical characteristics of these claims are inherent to the products described and exemplified. As such, just as the Examiner held that the claims were described in granting the '297 patent, he must hold that these claims are described as well. A copy of the Declaration under 37 CFR 1.132 filed in the parent application is presented herewith in further support of the claims.

The Examiner has rejected claims 44-54 stating that the specification does not describe the invention or enable one of ordinary skill in the art to make or use the full scope of the claims as the claims are not limited to the iterative process by which they are made.

There is no legal authority presented that supports the proposition that a claim to a product must be limited to the process described in the specification which enables the claimed products, even in an unpredictable art. That is, it is not in dispute that the specification enables the manufacture of the claimed compositions (at least with respect to the transition metals and silicon), employing such an iterative process (as evidenced by

the numerous related patents that have already been issued). Thus, it is not in dispute that the specification teaches at least one enabled process. No more is required under the law. In fact, the USPTO did not require the claims of US Patent 6,572,792, a parent application, to be so limited. It appeared that the Examiner tentatively agreed with the undersigned during the interview in this respect.

Based upon the breadth of the exemplification provided to date, it is believed that Applicant has satisfied his burden for enabling the full scope of the claims. The USPTO has failed to meet its burden in establishing why the specification is not enabling for the scope of the claims.

Withdrawal of the rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,

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